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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,603	02/15/2002	Evan Rudolph Zweifel	10014562	2789

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EXAMINER
NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/077,603	ZWEIFEL ET AL.
	Examiner	Art Unit
	Hoang-Vu A Nguyen-Ba	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 February 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

1. This action is responsive to the application filed February 15, 2002.
2. Claims 1-28 have been examined.

Priority

3. This application is a continuation-in-part of application no. 09/924,773, filed August 8, 2001. This application repeats a substantial portion of prior Application, and adds and claims additional disclosure not presented in the prior application. This newly presented and claimed subject matter does not receive benefit of the filing date of the parent application. The priority date considered for this application is thus its actual filing date, i.e., February 15, 2002.

Oath/Declaration

4. The Office acknowledges receipt of a properly signed oath/declaration filed February 15, 2002.

Drawings

5. The drawings are objected to because of the following minor informalities:

- Figure 17, step 1710: the word “EXTENEING ROM” is mistyped.
- 6. Figures 2, 3, 4 and 15 should be designated by a legend such as – Prior Art – because only that which is illustrated in these figures and described in Applicant’s background of the invention are considered old. See MPEP § 608.02(g).

Appropriate correction is required.

Claim Objection

7. Claims 12 and 26 are objected to because of the following informalities:
an article – a – should be added before “given class of patch recipients.”

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claims 3, 4, 6, 7, 9, 10, 12, 14, 17, 18, 20, 21, 23 are 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- a. Indefinite:
- i. Claims 6, 9, 12, 20 and 23 recite the limitation “wherein patch visibility **may be** at least “all” or “limited” or “their equivalents.” The recitation of the limitation is in permissive language. The broadest reasonable interpretation of this limitation is that this feature of “may be all” or “may be their equivalents” is optional feature. The use of the verb “may be” renders the claim indefinite. Accordingly, any arguments that this feature provides patentable distinction over the prior art will be unpersuasive.
- ii. Claims 6, 7, 9, 10, 20, 21, 23 and 24 recite the limitation “limited.” It is unclear as to which degree is the limitation visibility is considered limited.
- iii. Claims 3 and 17 recite the limitation “highly reliable.” It is unclear as to how much reliable is the reliability “highly reliable?”

iv. Claim 4, 14 and 18 recite the limitation “acceptable reliability.” It is unclear as to how much reliable is the reliability acceptable.

b. Lack of antecedent basis:

i. Claims 3 (line 2), 4 (line 2) and 18 (lines 2-3) recite the limitation “the patch tree.” There is insufficient antecedent basis for this limitation in the claim.

ii. Claim 17 recites the limitation “the same patch tree.” There is insufficient antecedent basis for this limitation in the claim.

iii. Claim 17 recites the limitation “the same or greater reliability.” There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 15-28 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 merely recites a selection system for aiding in the selection of program patches for installation into computer systems comprising a patch search mechanism, a patch chain examination mechanism, a patch presentation mechanism. These mechanisms are performed by components that are merely software components, i.e., computer program per se. Such claimed matter,

which is descriptive material *per se*, non-functional descriptive material is not statutory because it is not a physical “thing” nor a statutory process as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer’s program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer’s functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is thus mandatory. *Warrendam*, 33 F.2d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106 (IV)(B)(1)(a).

On this basis, claim 15 is rejected under 35 U.S.C. § 101.

Claims 16-28, which depend from claim 11, are also rejected under 35 U.S.C. § 101 for the same reasons.

Claim Rejections – 35 U.S.C. § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 1-4 and 15-18 are rejected under 35 U.S.C. § 102(a) as being anticipated by the admitted prior art (APA) of Figures 2-4, 15 and pages 1-4 of applicants' background.

Claims 1 and 15

APA discloses at least:

searching for a patch that corrects a particular defect or that has a particular property or both (see at least Figure 15 and related discussion in the specification);

examining additional patches, if any, sharing the same patch chain as any such patch found as a result of the search and occupying a position on the shared patch chain between that of any such patch found and the root of the patch chain (see at least Figure 15, e.g., patch tree 1504 and related discussion in the specification); and

presenting one or more patches, including any such patch found and examined patches that satisfy one or more specified conditions determined by the nature of each patch and the identity of the patch recipient (see at least Figure 15, e.g., "(2)" in "PATCH_10(2)" of patch tree 1504 and related discussion in the specification).

Claims 2 and 16

The rejection of base claims 1 and 15 are incorporated. APA further discloses *wherein at least one specified condition to be satisfied by presented patches is reliability adequate to the requirements or attributes or both of a given patch recipient (see at least Figure 15, e.g., "(2)" in "PATCH_10(2)" of patch tree 1504 and related discussion in the specification).*

Claims 3 and 17

Rejections of base claims 1, 15 and intervening claims 2, 16 are incorporated. APA further discloses *wherein any patch found is presented along with*

the patch closest to the root of the patch tree having the same or greater reliability to a recipient in need of highly reliable patches (see at least Figure 15, e.g., “(2)” in “PATCH_10(2)” of patch tree 1504 and related discussion in the specification).

Claims 4 and 18

The rejection of base claim 1 and 15 are incorporated. APA further discloses *wherein any patch found and any patch closest to the root of the patch tree having acceptable reliability is presented to a recipient in need of patches having acceptable reliability* (see at least sections [0007] and [0008]).

Claim Rejections – 35 USC § 103

14. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-14 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA, as applied to base claims 1 and 15 in view of U.S. Patent No. 5,809,230 to Pereira.

Claims 5 and 19

The rejection of base claims 1 and 15 are incorporated. APA does not specifically disclose *wherein at least one condition to be satisfied by presented patches is visibility to a given class of recipients*. However, Pereira teaches display of a program

group access function (Figure 4, item 100 and related discussion in the specification) and of a list of authorized users currently on the system (Figure 2, item 50 and related discussion in the specification) for the purpose of providing an access control program for a PC that may be tailored to limit access to programs, files and other resources of the PC differently for each user (5:54-57).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with patch visibility to a given class of recipients as taught by Pereira for the purpose discussed above.

Claims 6 and 20

Rejections of base claims 1, 15 and intervening claims 5, 19 are incorporated. APA does not specifically disclose *wherein patch visibility may be at least "all" or "limited" or their equivalents*. However, Pereira teaches how to give full access (i.e., “visibility” and “all”) of resources to users of the system (see at least Figure 3, item 92 and related discussion in the specification) for the same purpose discussed above in conjunction with the rejection of claims 5 and 19.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with all or limited patch visibility to a given class of recipients as taught by Pereira for the purpose discussed above.

Claims 7 and 21

Rejections of base claims 1, 15 and intervening claims 5-6, 19-20 are incorporated. APA does not specifically disclose *wherein only some patch recipients*

are permitted to be presented with patches whose visibility is "limited." However, Pereira teaches this feature. See discussion in claims 5-6 and 19-20 rejections.

Claims 8 and 22

The rejection of base claims 1 and 15 are incorporated. APA does not specifically disclose *wherein at least one condition to be satisfied by presented patches is availability to a given class of patch recipients.* However, the Office interprets patch availability to be equivalent to patch visibility since the system only allows a user to see which patches that are available to him/her. Therefore, the same rejections set forth above also apply to claims 8 and 22.

Claims 9 and 23

Rejections of base claims 1, 15 and intervening claims 5, 19 are incorporated. APA does not specifically disclose *wherein the availability of patches may be set to at least "all" or "limited" or their equivalents.* However, claims 9 and 23 are deemed rejected for the same reasons discussed in conjunction with claims 6, 8 and 20, 22.

Claims 10 and 24

Rejections of base claims 1, 15 and intervening claims 8-9, 22-23 are incorporated. APA does not specifically disclose *wherein only some patch recipients are permitted to be presented with patches whose availability is "limited."* However, claims 10 and 24 are deemed rejected for the same reasons discussed in conjunction with claims 7 and 21.

Claims 11 and 25

The rejection of base claims 1 and 15 are incorporated. APA does not specifically disclose *wherein at least two specified conditions to be satisfied by presented patches are reliability adequate to the needs or desires of a given patch recipient and visibility to a given class of patch recipients.* However, the anticipation of patch reliability requirements and the obviousness of patch visibility requirements have been previously addressed. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with the combination of patch reliability and visibility requirements for the same purpose discussed above in claims 5 and 19.

Claims 12 and 26

The rejection of base claims 1 and 15 are incorporated. APA does not specifically disclose *wherein at least two specified conditions to be satisfied by presented patches are reliability adequate to the needs or desires of a given patch recipient and availability to given class of patch recipients.* However, the anticipation of patch reliability requirements and the obviousness of patch availability requirements have been previously addressed. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with the combination of patch reliability and availability requirements for the same purpose discussed above in claims 8 and 22.

Claims 13 and 27

The rejection of base claims 1 and 15 are incorporated. APA does not specifically disclose *wherein at least two specified conditions to be satisfied by presented*

patches are visibility and availability to given classes of patch recipients. However, the obviousness of patch visibility requirements and patch availability requirements have been previously addressed. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with the combination of patch visibility and availability requirements for the same purpose discussed above in claims 5, 8 and 19, 22.

Claims 14 and 28

The rejection of base claims 1 and 15 are incorporated. APA further discloses *wherein at least three specified conditions to be satisfied by presented patches are reliability adequate to the needs or desires of a given patch recipient, visibility to a given class of patch recipients, and availability to a given class of patch recipients.*

However, the anticipation of patch reliability requirements and the obviousness of patch visibility requirements and patch availability requirements have been previously addressed. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Pereira with APA as this would provide APA with the combination of patch reliability, visibility and availability requirements for the same purpose discussed above in claims 2, 5, 8 and 16, 19, 22.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba

whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 6:45 to 16:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**ANTONY NGUYEN-BA
PRIMARY EXAMINER**

Art Unit 2122

November 12, 2004